

### REMARKS

Claims 1-28 are pending in this application.

Claims 1-2, 8-9, 14, 17 and 24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting over copending Application No. 10/228,158.

Claims 1-24 are rejected under 35 U.S.C. § 102(e).

Claims 25-28 are rejected under 35 U.S.C. § 103(a).

#### Provisional Rejection for Obviousness Type Double Patenting

The Examiner has not made out a *prima facie* case for the reasons previously stated. The Examiner has not performed the required comparison of claim language between the other application to this one. It is the Examiner's burden of proof, so Applicants need not do anything more until the Examiner follows the required steps.

Since this is a only provisional rejection, we suggest that we agree to disagree, unless the other case actually issues before this one.

#### Rejection Under 35 U.S.C. § 102(e) of Claims 1-24

The Examiner rejects **claims 1-24** under 35 U.S.C. § 102(e) as anticipated by Alie et al. (U.S. Publication 2003/0040947 A1).

##### Claims 1, 8, 14, 17 and 24

Regarding the independent claims 1, 8, 14, 17 and 24, an escrow agent is required by Alie and there is no provision for an importer's approval to pay. As Alie lacks this element that appears multiple times in the claims, a rejection under § 102 is misplaced.

The Examiner counters (FOA at 3-4) that Alie includes "that on receiving the shipment information the purchaser (importer) provides the payment instructions to the banking system ..." **The Examiner's counter does not read on these claims**, because the "payment instructions" to which the Examiner refers are escrow instructions and are conditional. They do not approve payment and are not an "approval to pay". Alie's system does not provide for "*the importer to electronically approve payment to the exporter by the importer's bank from the credit facility or demand deposit account*" as claimed. Instead, Alie provides for the importer to issue escrow instructions

and for a different actor, the escrow agent, to electronically approve payment upon receipt of goods in escrow. Our claim calls for the importer to approve payment following the importer's evaluation that the conditions for payment have been fulfilled etc. *See, Applic.* ¶¶ 0031, 0037 and 0043. It also calls for the payment to be made from a credit facility or demand deposit account at the importer's bank. In *Alie*, the importer surrenders control when it hands over funds to the escrow agent. The escrow agents "iCod bank" is neither the importer's bank nor the exporter's bank, it is the escrow agent's bank. *Alie*, ¶ 0044 ("The I-COD web site 13 then instructs 113 the I-COD bank 12 to remit the payment to the seller's bank 28.") The payment is made from an escrow account, not a credit facility or a demand deposit account. The system takes away from the importer any control over whether an approval to pay is issued, after funds are deposited into an escrow account (which is the familiar reason to use escrows and escrow agents.) The escrow agent either issues an approval to pay or does not and the importer has no control over what happens.

The Examiner will recall that we explained (Resp. at 12-13) *Alie*'s teaching of "Identifying a location at which a COD (cash-on-delivery or collect-on-delivery) exchange will take place, facilitated by a combined escrow of both the package and payment." The Examiner did not disagree regarding how *Alie* works, so we take it that our description is accurate. The Examiner's response completely ignores our discussion of the reference as a whole, despite the direction of the MPEP, the courts and the words of § 103(a) for the Examiner to consider both the reference and the claim "as a whole." 35 U.S.C. § 103(a); *see*, MPEP § 2141 (II) at 2100-117 (Rev. 5, Aug. 2006) *citing Hodos v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). When the reference and our claim are compared and contrasted as a whole, it is apparent that much different approaches are taken.

Therefore, the § 102 rejection of the independent claims should be withdrawn.  
Claims 2, 9 and 18

Regarding dependent claims 2, 9 and 18, which call for authorizing participants to view images of documents, the Examiner first relied on paragraphs 0025-0026, but shifted to what is "implied" by paragraphs 0035 and 0038 when we pointed out that paragraphs 0025-26 do not discuss about viewing document images or setting authorizations for viewing document images. The Examiner's argument about what is

implied tacitly admits that the limitations claimed are not expressly disclosed. Viewing document images is not implied, either, because there is no disclosure of capturing document images. The data captured for export and import is called out in detail in ¶ 0026, as

The import and export information preferably includes such information as, a date of shipment, a shipping service account number for shipping service charges associated with the transaction, names of the parties involved in the transaction, origin and delivery addresses, contact names, phone numbers and email addresses, and a cost breakdown of the shipping costs. More preferably, the import and export information includes a shipment tracking number, a transaction reference number (such as a purchase order or invoice number), the value of the goods being shipped, a description of the goods being shipped, the currency of payment and a harmonized tariff code.

An advantage of this data entry, explained in ¶ 0012, is elimination of re-entering the shipment information, including the export and import information. **Since there is no teaching of image capture and the details given in the application suggest that data, not images, are captured, there is no basis for implying in ¶¶ 0035 & 0038 any image viewing.**

Therefore, rejection under § 102 should be withdrawn.

#### Claims 3, 10 and 19

Regarding dependent claims 3, 10 and 19, which call for exchange of draft conditions, the Examiner relied on much of the publication, without singling out any particular passage, but then focused on 0041-0044. (FOA at 5) Now, the Examiner argues that it is implied that the I-COD system handles exchange of draft conditions. To the contrary, ¶ 0041 teaches that an agreement is reached before the I-COD payment system is selected.

Before using the delivery system 10, the seller 16 and purchaser 17 agree to the terms of the transaction 101. For instance, the purchaser may log on to a retail or wholesale web site of the seller, select merchandise from the web site for purchase, agree to a payment amount and agree to a shipping method, i.e., use of the I-COD system 10.

Moreover, **the I-COD payment system does not involve any exchange of draft conditions, as the escrow exchange of a package for a payment is simple and unencumbered.** See, ¶ 0046.

Therefore, rejection under § 102 should be withdrawn.

Claims 4 and 20

Regarding dependent claims 4 and 20, these claims should be allowed for at least the same reasons as the claims from which they depend.

Claim 5

The bank in dependent claim 5, as amended, that executes the payment to the exporter is the importer's. In Alie, the I-COD bank executes the payment, and not on an approval to pay by the importer, but on instructions from the escrow agent who Alie has unequivocally described as holding the package in escrow.

The Examiner stresses ¶ 0043 as teaching payment from the purchaser's bank upon receipt of instructions. **However, the payment is not to the exporter, it is into an escrow account. The only payment in Alie that goes to the exporter is from the escrow account, not from the importer's bank.**

Therefore, rejection under § 102 should be withdrawn.

Claims 6, 12, 15 and 22

Regarding dependent claims 6, 12, 15 and 22, these claims call for exposing to view conditions and instructions for payment, the documentation of fulfillment and the approval of fulfillment or the abatement or waiver of the conditions for payment. The Examiner refers to tracking system 45, information system website 13 and shipment order system 38, using reference numbers from Alie's figures. The web site is the place that Alie would expose information to view. Paragraphs 0032-0035 describe the limited capabilities of Alie's web site.

In the FOA, at 6, the Examiner asserts that the purchaser is in condition to "approve, abate or waive fulfillment conditions of payment" according to ¶ 0043 upon receipt of notification that shipment has been made. Paragraph 0043 reads:

The shipment notification sent to the purchaser includes a description of the goods and payment instructions. Preferably, the payment instructions include a number of the account 26 at the I-COD bank, or payment system 12. The purchaser 17 then provides 106 the payment instructions to the purchaser's bank, or funds account 27. The payment instructions authorize payment and allow the purchaser's bank 27 to electronically transmit 107 and deposit the payment in the I-COD bank account 26. The I-COD bank 12 notifies 108 the I-COD web site 13 of receipt of the payment.

There is no mention in this text of the system exposing to view conditions and instructions for payment, the documentation of fulfillment and the approval of fulfillment or the abatement or waiver of the conditions for payment. The importer sees the "description of the goods" shipped and either deposits money in escrow or does not.

**The importer's decision to deposit money into escrow or not does not read on these claims.**

Therefore, rejection under § 102 should be withdrawn.

Claims 7, 13, 16 and 23

Regarding dependent claims 7, 13, 16 and 23, these claims describe how a system implements a workflow by exposing role-oriented status of responsibilities to carry out a series of listed next steps.

In the FOA, at 6-7, the Examiner refers to Alie FIGS. 1-4 as showing the structure and workflow process. "All the shipping participants ...I have roles to play and are responsible to carry out their individual responsibilities in completing the transaction." That assertion does not read on these claims. Of course, everyone has to do their job to complete a transaction; that is a syllogism. The Examiner's assertion does not say anything about what Alie's system does to support the transaction. In particular, **Alie does not expose role-oriented status of responsibilities to carry out a series of listed next steps, because Alie teaches a payment system and not any details of a logistics support system.** The ¶ 0043, set forth above, is again relied upon by the Examiner and again fails to read on the limitations of these claims.

Therefore, rejection under § 102 should be withdrawn.

Claims 11 and 21

Regarding dependent claims 11 and 21, these claims call for the importer's bank to generate status updates. The importer's bank does not have the role in Alie that it has in the claims of this application. The importer's bank sends money to the escrow agent's bank, kaput. The purchaser's bank in Alie does not generate the claimed status updates.

In the FOA at 7, **the Examiner equates the I-COD website to the purchaser's bank, and thereby ignores Alie's teaching that the purchaser's bank and the I-COD bank are separate entites.** *Alie*, ¶ 0044 ("The I-COD web site 13 then instructs 113 the I-COD bank 12 to remit the payment to the seller's bank 28.")

Therefore, rejection under § 102 should be withdrawn.

### **CONCLUSION**

Applicants respectfully submit that the pending claims are now in condition for allowance and thereby solicit acceptance of the claims as now stated.

Applicants would welcome an interview, if the Examiner is so inclined. The undersigned can ordinarily be reached at his office at (650) 712-0340 from 8:30 a.m. to 5:30 p.m. PST, Monday through Friday, and can be reached at his cell phone at (415) 902-6112 most other times.

***Fee Authorization.*** The Commissioner is hereby authorized to charge underpayment of any additional fees or credit any overpayment associated with this communication to Deposit Account No. 50-0869 (TRDB 1006-1).

Respectfully submitted,

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